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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,974	02/25/2004	Daniel Davitz	36008.00.0002	4118
23418	7590	04/05/2006	EXAMINER	
VEDDER PRICE KAUFMAN & KAMMHOLZ 222 N. LASALLE STREET CHICAGO, IL 60601			MORILLO, JANELL COMBS	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/786,974	DAVITZ, DANIEL
	Examiner Janelle Combs-Morillo	Art Unit 1742

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 20 January 2006.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-25 is/are pending in the application.  
 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-8 and 17-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 17-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of said claims is unclear because of the use of different transitional phrases when referring to the instant alloy composition- “consisting essentially of” and “comprising”. It is unclear if applicant intended the claim scope to be open or closed. For the purposes of this office action, the examiner has interpreted the claims in the broadest scope, consistent with “comprising” type claim language. If applicant intended for the claim language to be consistent with “consisting essentially of” type claim language, and wherein the hardening element consists of only Cu (and wherein Sn and In are optional, and limitations of dependent claims), the following claim language is suggested by the examiner-

“17. (amended) A silver-colored, tarnish-resistant, corrosion-resistant alloy consisting essentially of:

92.5-95% by weight silver, the balance of which is an alloy consisting essentially of:  
approximately 24-34% by weight zinc;

approximately 0.5-1.8% by weight silicon;

[and further comprising] hardening agents consisting of approximately 60-74% by weight copper, optionally 0-8% by weight Sn, and optionally 0.9%±0.05% by weight In.”

“18. (amended) The alloy of claim 17, [and further comprising] having approximately 0-8% by weight tin.”

	instant claim 1		net alloy		claims 4 and 7	net alloy	
	min.	max.	min.	max.		min.	max.
Ag	92.50%	95%	92.50%	95%	92.5-95%	92.50%	95%
balance an alloy comprised of:			7.50%	5%		7.50%	5%
Zn	24%	34%	2.55%	1.20%	29.75%	2.23%	1.49%
Cu	60%	74%	5.55%	3.00%	62.15%	4.66%	3.11%
Si	0.5%	1.8%	0.14%	0.03%	1.35%	0.10%	0.07%
Sn	0%	8%	0.60%	0.00%	6.75%	0.51%	0.34%

Table 1: Alloying Ranges Of (amended) Claim 1

	cl. 1, 17	cl. 2	cl. 3	cl. 4 and 7	cl. 5	cl. 6, 8	Eccles	Bernhard
Ag	92.5-95%	92.5-95%	92.5-95%	92.5-95%	92.5-95%	92.5-95%	preferably >92.5% Ag	89-93.5%
Balance (assumed 5-7.5%):								
Zn	1.5-2.2%	1.1-1.9%	1.5-2.6%	1.5-2.2%	1.2-1.8%	1.6-2.5%	0.05-5%	0.5-5%
Cu	3.1-4.7%	3.5-5.9%	3.1-5.1%	3.1-4.7%	3.7-5.6%	3.2-4.9%	0.5-6%	0.5-6%
Si	0.07-0.10%	0.06-0.09%	0.03-0.05%	0.07-0.10%	0.06-0.09%	0.03-0.05%	0.02-2.0%	0.02-2%
Sn	0.3-0.5%		0.01-0.02%	0.3-0.5%		0.05-0.07%	0.25-6%	0.25-6%
In			0.04-0.06%			0.06-0.09%	opt. 0.01-1.5%	0.01-1.25%
other							0.01-2.0% Ge	0.001-2% B

Table 2: Approximate Net Alloying Ranges vs. prior art

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 and 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernhard et al (US 5,039,479).

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Bernhard teaches a Silver based alloy that overlaps the instant net alloying ranges (see Table 2, above). Bernhard teaches the addition of 0.001-2% B to said alloy, however, it is not clear that these additions are not excluded by the instant claim language.

The net alloying ranges of instant claims 17-25 are given in Tables 3-5 below. Because of the broad overlap in alloying ranges, it is held that Bernhard has created a *prima facie* case of obviousness of the presently claimed invention.

	claims 17, 18, 19		net alloy	
	min.	max.	min.	max.
Ag	92.50%	95%	92.50%	95%
balance an alloy comprised of:			7.50%	5%
Zn	24%	34%	2.55%	1.20%
Cu	60%	74%	5.55%	3.00%
Si	0.5%	1.8%	0.14%	0.03%
Sn (18)	0%	8%	0.60%	0.00%
In (19)	0.85%	0.95%	0.07%	0.04%

Table 3

	claim 20, 21, 22		net alloy	
	min.	max.	min.	max.
Ag	92.50%	95%	92.50%	95%
balance an alloy comprised of:			7.50%	5%
Zn	24%	34%	2.55%	1.20%
Cu	60%	74%	5.55%	3.00%
Si	0.5%	1.8%	0.14%	0.03%
In (22)	0.85%	0.95%	0.07%	0.04%
Sn (21)	1.14%	1.26%	0.095%	0.057%

Table 4

	claims 23, 24, 25		net alloy	
	min.	max.	min.	max.
Ag	92.50%	95%	92.50%	95%
balance an alloy comprised of:			7.50%	5%
Zn	30.97	34.23	2.56725	1.5485
Si	0.57	0.63	0.04725	0.0285

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Cu	61.46	67.94	5.0955	3.073
In(25)	0.85	0.95	0.07125	0.0425
Sn(24)	1.14	1.26	0.0945	0.057

Table 5

***Response to Amendment***

5. In the response filed on January 20, 2006 applicant amended claims 1-8, 17, 20, 23, and submitted various arguments traversing the rejections of record.
6. Claims 17-25 still contain different transitional phrases when referring to the instant alloy composition- “consisting essentially of” and “further comprising” (see discussion above).
7. Applicant has overcome the rejections in view of Eccles. However, it is not clear that the instant claims exclude B- as either a hardening agent, or excluded by the “consisting essentially of” transitional phrase. The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). The applicant has not shown that the addition of B would materially affect the basic and novel characteristics of the claimed invention.
8. Applicant states (see reply on page 13) that germanium and boron are hardening elements excluded by the instant claims, though the prior art teaches that germanium is a hardening element, it is not clear that B is a hardening element, and therefore excluded by the instant claim language.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 8:30 am- 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JCM  
March 30, 2006

  
GEORGE WYSLOMIERSKI  
PRIMARY EXAMINER  
GROUP 1700